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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,423	01/30/2002	Mibuko Shimada	218932US0	4742

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EXAMINER	
KEEHAN, CHRISTOPHER M	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 05/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application No. 10/058,423	Applicant(s) SHIMADA ET AL.	
	Examiner Christopher M. Keehan	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 January 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "particles" in the claim. There is insufficient antecedent basis for this limitation in the claim. Perhaps adding "and having particles of --- therein" or something along those lines would help clarify the claim. As written, it is also not clear what the particles are composed of, and this appears to read on any component of the composition. Further, the claim language "the maximum size of particles contained therein is 2 μm or less" can read on a particle with a size of zero, which therefore cannot be present. The claim language "and the number of particles having a size of 0.2 μm to 2μm is 1,000 particles/ml or less" is not clear. This range can read on an amount of zero particles/ml, which would therefore indicate that the claimed particles are not present at all.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sekiguchi et al. (6,207,728 B1). Regarding claims 1, 2, 5-15, Sekiguchi et al. disclose polymer composition as instantly claimed (Abstract and col.17, lines 45-50). Although Sekiguchi et al. do not appear to specifically disclose the range of particles having a size of 0.2 μm to 2μm is 1,000 particles/ml or less, it appears this is inherently disclosed because the composition of Sekiguchi et al. is the same as applicant's, and the same materials would have yielded a product with the same inherent properties. If not inherent, then it would have been obvious to one of ordinary skill in the art at the time the invention was made for the composition of Sekiguchi et al. to have achieved at least similar inherent properties, such as those as instantly claimed, because at least similar materials would have yielded at least similar properties, absent evidence to the contrary.

Regarding claim 3, Sekiguchi et al. disclose the instantly claimed recurring unit (col.12, lines 1-30).

Regarding claim 4, Sekiguchi et al. disclose a weight average molecular weight as instantly claimed (col.11, lines 18-30).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome

either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2, 4-12, and 14-15 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shimada et al. (2000-191977, machine translation). The examiner is relying on the machine translation for this document and is attached hereto. Regarding claims 1, and 8-15, Shimada et al. disclose a polymer composition comprising a polymer having a silicon bound to a hydrolytic group (section 00023). Shimada et al. also appear to inherently disclose the instantly claimed inherent properties. The composition of Shimada et al. appears to be the same as applicant's, and the same materials would have yielded a product with the same inherent properties. If not inherent, then it would have been obvious to one of ordinary skill in the art at the time the invention was made for the composition of Shimada et al. to have achieved at least similar inherent properties, such as those as

instantly claimed, because at least similar materials would have yielded at least similar properties, absent evidence to the contrary.

Regarding claim 2, Shimada et al. disclose at least one component selected from the group as instantly claimed (section 0008).

Regarding claim 4, Shimada et al. disclose a number average molecular weight of 800-100,000 (sections 0040 and 0052). Although Shimada et al. do not disclose a weight average molecular weight as instantly claimed, it appears the range of Shimada et al. is included in applicant's range because in the specification (page 15, lines 17-19), applicant discloses a number average molecular weight of from 1,000 to 100,000. In the claim, applicant claims a weight average molecular weight of 1,000 to 100,000. Applicant appears to have equated the two values and therefore the value of Shimada et al. also is included within the claimed range.

Regarding claim 5, Shimada et al. disclose a photoacid generating agent (sections 0062-0064).

Regarding claim 6, Shimada et al. disclose a dehydrating agent (section 0091).

Regarding claim 7, Shimada et al. disclose a cured film (section 0062).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 7-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamada et al. (6,051,665). Regarding claims 1, 2, and 7-15, Yamada et al. disclose a polymer composition as instantly claimed (Abstract, col.8, lines 51-61, and col.17, lines 41-44). Although Yamada et al. do not specifically disclose the instantly claimed inherent properties, it appears these properties are inherently disclosed, as the composition of Yamada et al. appears to be the same as applicant's, and the same materials would have yielded a product with the same inherent properties. If not inherent, then it would have been obvious to one of ordinary skill in the art at the time the invention was made for the composition of Yamada et al. to have achieved at least similar inherent properties, such as those as instantly claimed, because at least similar materials would have yielded at least similar properties, absent evidence to the contrary.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (703) 305-2778. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on 308-2340. The fax phone numbers

for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Christopher Keehan

April 30, 2003

Robert Dawson
Supervisory Patent Examiner
Technology Center 1700